

REMARKS/ARGUMENTS

In response to the Examiner's Office Action of April 27, 2009 issued in relation to the present Patent Application, the Applicant submits the below Remarks.

Claims 1-4, 8, 11, 14, 17, 20, 27-29, 32-35, 41, and 47 remain pending in the application. Claims 1, 27 and 47 are independent claims.

Regarding 35 USC 103(a) Rejections

Claims 1, 2, 4, 11, 14, 17, 27-29, 33, 35 and 47 are rejected as being unpatentable over Lubow et al (US Pub. No. 2006/0118631) in view of Pinchen et al. (US 7,188,774) and in further view of Kurokawa (US 5,625,467).

Claims 3, 8, 32 and 34 are rejected as being unpatentable over Lubow et al in view of Pinchen et al., in further view of Kurokawa, and yet further in view of Klein (US Pub. No. 2001/0037248).

Claims 20 and 41 are rejected as being unpatentable over Lubow et al in view of Pinchen et al., Kurokawa, Klein, and further in view of Endoh (US 5,818,031).

Claim 1 defines: "the data of each coded data portion being indicative of the product identity data and of the respective positions of the coded data portions on the interface surface." Lubow is relied upon for teaching a bar-code which is indicative of product identity data, whereas Kurokawa is relied upon for teaching a bar-code which is indicative of a respective position of the bar-code on a interface surface.

Examiner asserts that it would have been obvious to modify Lubow et al's teaching to incorporate the position information as part of the coded data forming a composite bar code by precisely printing a second code next to a first one whose relative position can be obtained by scanning itself. Examiner has failed to identify where in the prior art the teaching, suggestion or motivation is found to combine the teachings of the prior art and to modify the teaching of Lubow in the suggested manner. MPEP at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*") specifies that obviousness can only be established if three criteria are met, including:

(1) First, there must be some teaching, suggestion or motivation to combine or modify teachings of the prior art to produce the claimed invention found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;

Given the bar-codes of Lubow, the first which identifies a product and the second which identifies a lot, batch, expiration date or commodity number, Applicant can find no motivation in either Lubow or Kurokawa to add to either of those bar-codes a third bar-code which encodes its position on the surface. Lubow has attributed no value to the position of the respective bar-codes, and has failed to express any need for encoding such additional data.

In order to establish obviousness, it is insufficient to establish that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. Also, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is not permissible to use the

claimed invention as a “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

The Examiner has thus failed to establish a prima facie case of obviousness.

Claims 2-4, 8, 11, 14, 17, 20, 28, 29, 32-35, and 41 are dependent on one of claims 1 or 27, and are allowable for at least that reason.

CONCLUSION

It is respectfully submitted that all of the Examiner's rejections have been traversed. Accordingly, it is submitted that the present application is in condition for allowance and reconsideration of the present application is respectfully requested.

Very respectfully,



Kia Silverbrook, Managing Director

Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: patentdept@silverbrookresearch.com
Telephone: +612 9818 6633
Facsimile: +61 2 9555 7762